



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,255	08/02/2001	Petteri Heinonen	2132-50PCON	2545

7590 05/21/2007
COHEN, PONTANI, LIEBERMAN & PAVANE
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER

WEIS, SAMUEL

ART UNIT	PAPER NUMBER
----------	--------------

3691

MAIL DATE	DELIVERY MODE
-----------	---------------

05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/923,255	Applicant(s) HEINONEN ET AL.	
	Examiner Samuel S. Weis	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,7,14,17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8, 10-13, 15, 16, 18, 20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3, 4, 6, 8, 10-13, 15, 16, 18, 20 and 22-24 are presented for examination. Applicant filed an amendment on 2/21/2007 canceling claims 2, 5, 7, 14, 17, and 19 and amending claims 1, 3, 4, 6, 8, 10-13, 15, 16, 18, 20 and 22-24. In view of Applicant's amendment, the Examiner withdraws the grounds of rejection of claims 1-24 based on 35 U.S.C. §112. After careful consideration of Applicant's arguments and amendments, the rejection of claims 1, 3, 4, 6, 8, 10-13, 15, 16, 18, 20 and 22-24 are maintained as set forth in detail below.

Claim Objections

2. Claim 4 objected to because of the following informalities: claim 4 is dependent on a cancelled based claim. It is assumed that claim 4 is dependent on amended claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 6, 8, 13, 15, 16, 18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al., U.S. Pat. No. 6,282,522 (hereinafter, Davis).

As to claims 1 and 13, Davis discloses a method for transmission of messages (abstract) comprising:

optimizing exchange of payment messages between the payment application and the payment server over an interface defined at least in part by the telecommunication connection between the smart card client and the smart card server by (i.e. security card delivers ... to reduce message traffic between entities on the network) (abstract; col. 21, lines 1-13))

receiving, with the smart card client from the payment application, a first message to be transmitted from the payment application to the payment server (i.e. draw request message) (col. 13, line 65 through col. 14, line 17),

storing the first message in the smart card client (col. 13, line 65 through col. 14, line 17),

sending, from the smart card client a first response message to the payment application (i.e. client module interacts with store value card) (col. 13, line 65 through col. 14, line 17),

sending, from the smart card client to the smart card server a second message comprised of at least some parts of the first message and the first response message (i.e. client terminal and merchant server exchange information via internet, client module, merchant server, and payment server use this unique transaction identifier for tracking and logging information about the transaction) (col. 13, lines 56-63)

storing the second message in the smart card server (i.e. merchant server registers confirmation message) (Fig. 11C) ;

Art Unit: 3691

sending a third message from the smart card server to the payment server, based on the second message (i.e. merchant server is able to generate its own confirmation message,) (col. 22, lines 46-48);

receiving a second response message with the smart card server from the payment server (i.e. payment server builds a result message containing the identification of the transaction and sends it to client terminal) (col. 14, lines 10-12), and

sending, from the smart card server to the smart card client, a fourth message comprised of at least some parts of the second message and the second response message (i.e. after determining that the transaction was successful, merchant server sends it to client terminal) (col. 14, lines 14-16).

As to claims 3 and 15, Davis discloses a method in accordance with claim 1, wherein the first response message is termed as a message from the payment server (i.e. payment server sends debit command to client terminal) (col. 17, lines 12-16).

As to claims 4 and 16, Davis discloses a method in accordance with claim 1, wherein the first response message is responsive to a message received by the smart card client from the smart card server over the telecommunication connection (i.e. client terminal accesses payment server using IP address received from merchant server and client server sends message to payment server) (col. 16, lines 53-58).

As to claims 6 and 18, Davis discloses a method in accordance with claim 1, wherein the third message is formed as a message sent by the payment application (i.e. client module sends success message to payment server).

As to claims 8 and 20, Davis discloses a method in accordance with claim 1, further comprising:
initiating a payment application transaction with an initiating transmission of a payment message between the payment server and the payment application (i.e client terminal communicates with payment server, first by forwarding the draw request to the payment server) (col. 14, lines 4-7), and after said initiating transmission, continuing transmission of payment messages via the smart card client and the smart card server (i.e. message is then routed to merchant server via client terminal and merchant server then validates the result message) (col. 14, lines 12-14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 12, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Skog (U.S. Pat. No. 5,930,701).

As to claims 10 and 22, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using USSD protocol. However, Skog teaches a method for enabling a mobile telecommunications network in which data can be sent over USSD (Unstructured Supplementary Service Data) protocol (col. 2, lines 29-35). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Skog within Davis for the motivation for communicating using USSD protocol.

As to claims 12 and 24, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using GPRS protocol. However, Skog teaches a method for enabling a mobile telecommunications network in which data can be sent over GPRS protocol (col. 2, lines 29-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Skog within Davis for the motivation for communicating using GPRS protocol.

7. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Gershman et al (hereinafter, Gershman) (U.S. Pat. No. 6,199,099).

As to claims 11 and 23, Davis does not explicitly disclose wherein communication via the telecommunication connection is implemented using WAP.

However, Gersham teaches a method for obtaining information utilizing a distributed communication network in which data can be sent over WAP (wireless access protocol) (col. 1, lines 44-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include the aforementioned limitations as disclosed by Gershman within Davis for the motivation for communicating using WAP.

Response to Arguments

8. Applicant's arguments filed 2/21/2007 have been fully considered but they are not persuasive.

As to Applicant's arguments to the rejections of claims 1-24 based on 35 U.S.C. §112, the Examiner withdraws the rejection of the claims based on the Applicant's amendments and arguments.

The Applicant argues that Davis does not teach, suggest, or contemplate "the optimization of messages effecting the transactions." The Applicant defines optimization as "this optimization reduces the number of messages that are or need to be transmitted over the telecommunication connection, thereby realizing an advantageous savings in available radio interface capacity and enhancing security.

The Examiner respectfully disagrees that Davis does not disclose optimization of messages: directly in the abstract of Davis, "the security card delivers the expected smart card signature to the payment server and/or on to the client terminal or merchant server to reduce message traffic between the entities on the network." Also, "[I]n another embodiment 200b of the present invention as illustrated in FIG. 7, not only is the security card allowed to release earlier, but the number of messages exchanged between the client terminal and the payment server are reduced." (col. 20, line 66-col. 21, line3). It is an object of the invention of Davis to reduce the number of messages sent between entities in a smart card network therefore optimizing the message traffic.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

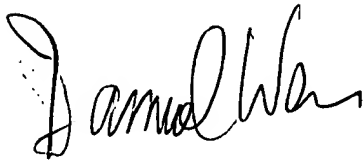
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel S. Weis whose telephone number is (571) 272-2025. The examiner can normally be reached on 8:30 to 5, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Samuel S. Weis



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER